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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,753	07/03/2003	Brenda Reeve	GOUD:032US	5649

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EXAMINER	
SOROUSH, LAYLA	
ART UNIT	**PAPER NUMBER**
1617	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/613,753	REEVE, BRENDA	
	Examiner	Art Unit	
	Layla Soroush	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The response filed November 15, 2006 presents remarks and arguments submitted to the office action mailed June 15, 2006 is herein acknowledged.

Applicant's arguments over the 35 U.S.C. 103 (a) rejection of claims 1-7, 10-19, 21-22, and 23 over Gervais (Pat. No. 6,340,695 - IDS) is not fully persuasive. Therefore, the rejection is herewith modified to incorporate added limitations.

Applicant's arguments over the 35 U.S.C. 103 (a) rejection of claims 8, 9, and 20 over Gervais (Pat. No. 6,340,695 - IDS) in view of Ansel et al. is not fully persuasive. Therefore, the rejection is herewith modified to incorporate added limitations.

Applicant's arguments over the Obvious Double Patenting rejection over U.S. Patent No. 6,340,695 is not fully persuasive. Therefore, the rejection is herewith modified to incorporate added limitations.

Upon further consideration of the amended claims, the following rejections are made:

Claim Rejections - 35 USC § 11 2

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any : person skilled in the ad to which it pertains, or with which It is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for prevention of post surgical vomiting. The specification does not enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. The specification does not provide sufficient information that post surgical vomiting is preventable using the method of administering to a patient undergoing general anesthesia a composition comprising Doxylamine Succinate and Pyridoxine Hydrochloride. The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation.

Attention is directed to In re Wands, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing Ex parte Forman, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

(1) the nature of the invention', (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims', (6) the amount of direction or guidance presented', (7) the presence or absence of working examples', and (8) the quantity of experimentation necessary. When the above factors are weighed, it is the examiner's position that one skilled in the art could not practice the invention without undue experimentation.

(1). The Nature of the Invention: All of the rejected claims are drawn to an invention which pertains to a method for the treatment or **prevention** or reducing post surgical vomiting, which comprises administering to a patient undergoing general anesthesia a composition comprising Doxylamine Succinate and Pyridoxine Hydrochloride.

(2). The state of the prior art: In the instant case, the specification does not provide guidance as to how one skilled in the art would accomplish the objective of preventing post surgical vomiting. Nor is there any guidance provided as to a specific protocol to be utilized in order to show the efficacy of the presently claimed composition comprising Doxylamine Succinate and Pyridoxine Hydrochloride for preventing post surgical vomiting.

(3). The predictability or unpredictability of the art: the art does not enable a person of ordinary skill in the art to make and use the claimed invention without resorting to undue experimentation. The burden of enabling one skilled in the art to prevent post surgical vomiting would be much greater than that enabling the treatment. In the instant case, the specification does not provide guidance as to how one skilled in the art would accomplish the objective of preventing post surgical vomiting. Nor is there any guidance provided as to a specific protocol to be utilized in order to show the efficacy of the presently claimed composition comprising Doxylamine Succinate and Pyridoxine Hydrochloride for preventing post surgical vomiting.

The specification fails to enable one of ordinary skill in the art to practice the presently claimed method for preventing post surgical vomiting. The term "prevention" or "preventing" is synonymous with the term "curing" and both circumscribe methods of treatment having absolute success. Since absolute success is not as of yet reasonably possible with most diseases/disorders, the specification is viewed as lacking an adequate enablement of where post surgical vomiting may be actually prevented.

(4). The breadth of the claims: the claims encompass a method for the treatment or **prophylaxis** of post surgical vomiting by administering a composition comprising Doxylamine Succinate and Pyridoxine Hydrochloride. Applicant fails to set forth the criteria that define the prophylaxis of the disease.

(5). The amount of direction or guidance presented: does not provide any guidance in terms of preventing post surgical vomiting.

(6). The presence or absence of working examples: applicant does not provide any working examples for the prevention of post surgical vomiting. The applicant has not provided any competent evidence or disclosed any tests that are highly predictive for the preventative effects of the instant composition.

(7). The quantity of experimentation necessary: the quantity of experimentation would be an undue burden to one of ordinary skill in the art and amount to the trial and error type of experimentation. Thus, factors such as "sufficient working examples, "the level of skill in the art' and "predictability" etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims. In view of the breadth of the claims, unpredictability of preventing post surgical vomiting, and the lack of working examples regarding the activity as claimed, one skilled in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7, 10-19, 21-23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gervais (Pat. No. 6,340,695 - IDS) in view of Apfel (PONV Research – reference provided).

Gervais teaches a rapid onset formulation comprising pyridoxine HCl and doxylamine succinate useful in the treatment of nausea and vomiting comprising admistration of a therapeutically effective amount of the composition (see, column 1 lines 5-11, column 11 lines 1-3, and specifically claim 27). The reference does not specifically teach "reducing post-surgical vomiting" or "treating post-surgical vomiting" comprising the administration before, during after (at regular intervals), before anesthesia, on an outpatient bases, on an evening prior to, a morning of the day of, immediately after surgery, as recited in claims 1-6, 13, 15-16, 18, and 19. However, the reference teaches the formulation of Doxylamine succinate and pyridoxine hydrochloride are used in the human and veterinary fields of medicine whenever symptoms of nausea and/or vomiting require medical intervention (column 2, lines 56-59)." The reference teaches oral dosage forms (column 2, lines 61-63), as recited in claim 7. Additionally, the reference teaches in Example 1 a formulation wherein

pyridoxine HCl and doxylamine succinate each weigh 10 mg/ tab, as recited in claims 11 and 23. The formulation and its components are in pharmaceutically acceptable carriers (e.g., magnesium trisilicate) (column 4, see Table 1), meeting the limitations of claims 10 and 22. The treatment of nausea and vomiting is especially, but not limited to, during pregnancy (column 1 lines 5-11), meeting the limitation of claim 14. The limitation "at substantially the same time," recited in claims 17 and 21, are met because the reference teaches the formulation in a tablet, pill or encapsulated beads or solution. Hence, the components are administered at "substantially the same time" in any form recited above.

Anpfel is solely used to show that PONV (postoperative nausea and vomiting) has been known in the prior art to be associated with general anesthesia.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Doxylamine succinate and pyridoxine HCl formulation to reduce post-surgical vomiting in patients undergoing general anesthesia because the reference teaches the treatment of vomiting and nausea in general. The motivation to administer the said formulation is because the prior art teaches the ingredients in treating nausea and vomiting (see claim 25, column 10, lines 62-64, and column 2, lines 56-61). Therefore, a skilled artisan would have reasonable expectation of treating post operative nausea and vomiting because Gervais teaches that the said formulation can be administered whenever symptoms of vomiting and nausea require medical intervention and Anpfel teaches PONV (postoperative nausea and vomiting) has been known in the prior art to be associated with general anesthesia.

In reference to Claim 12, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the dose range of Gervais compound by routine experimentation (see 2144.05 11). The motivation to optimize the dose range of the Gervais' final formulation is because he would have had a reasonable expectation of success in achieving the safest clinical outcome.

Claims 8, 9, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gervais (Pat. No. 6,340,695) in view of Apfel (PONV Research – reference provided) as applied to claims 1-7, 10-19, 21-23, and 24 above, and further in view of. Ansel et al.

Gervais and Apfel are discussed above.

The preferred formulation of the Gervais invention is in the form of an oral dosage form such as a tablet, pill or encapsulated beads or solution (column 2, lines 61-64). Further, the art teaches in the "most preferred embodiment, the formulation contains a core coated with an aqueous enteric coating. The core comprises the active ingredients pyridoxine HCl and doxylamine succinate (column 3, lines 39-42).

Gervais does not specifically teach a delayed release formulation.

Ansel et al. teaches delayed release products usually are enteric-coated tablets or capsules designed to pass through the stomach unaltered, later to release their medication within the intestinal tract (page 229, column 1, first paragraph).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the identical enteric-coated tablet with the

composition. The motivation to make such an incorporation is because Gervais teaches the preferred embodiment of the invention is a formulation that is entirically coated and further by Ansel's teaching that delayed release products are usually enterically-coated. The skilled artisan would have reasonable expectation of producing a similar composition with similar efficacy and delayed release properties.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 13-18 and 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25-29, and 30 of U.S. Patent No. 6340695) in view of Apfel (PONV Research – reference provided).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the co-pending application recites a method of

treating nausea and vomiting comprising administering a therapeutically effective amount of an enterically-coated pyridoxine HCl and doxylamine succinate rapid onset formulation, whereas the instant claims are to method of reducing post-surgical vomiting comprising administering to a patient undergoing general anesthesia a therapeutically effective amount of pyridoxine HCl and doxylamine succinate. To one of ordinary skill in the art it would be obvious to administer the identical composition with the expectation of producing similar efficacy and results, especially since the Anpfel reference teaches PONV (postoperative nausea and vomiting) has been known in the prior art to be associated with general anesthesia.

Response to Arguments

Applicant's arguments against the 35 U.S.C. 103 (a) rejections are not fully persuasive.

Examiner agrees that there is no explicit teaching of the treatment of post surgical vomiting comprising patients undergoing general anesthesia. However, upon the combinatorial teachings of Gervais (Pat. No. 6,340,695 - IDS) and Apfel references it would have been obvious to treat such conditions using the formulation comprising pyridoxine HCl and doxylamine succinate. The motivation to treat post surgical vomiting comprising patients undergoing general anesthesia is from the teachings of Gervais that Doxylamine succinate and pyridoxine HCl formulation are used in the human and veterinary fields of medicine whenever symptoms of nausea and/or vomiting require medical intervention (column 2, lines 56-59); and Anpfel's teachings that PONV (postoperative nausea and vomiting) has been known in the prior art to be associated

with general anesthesia. Therefore, a skilled artisan at the time of the invention would have reasonable expectation of successfully treating post surgical vomiting in patients undergoing general anesthesia.

Applicant's arguments that the "claimed invention provides surprising and unexpected results and (2) satisfies a long felt need which was recognized, persistent, and not solved by others," is not persuasive. The examiner reiterates that the prior art reference teaches Doxylamine succinate and pyridoxine HCl formulation are used in the human and veterinary fields of medicine whenever symptoms of nausea and/or vomiting require medical intervention (column 2, lines 56-59); and Anpfel teaches that PONV (postoperative nausea and vomiting) has been known in the prior art to be associated with general anesthesia. Therefore, a skilled artisan at the time of the invention would have reasonable expectation of successfully treating post surgical vomiting in patients undergoing general anesthesia.

Applicant's arguments with respect to the Gervais in view of Ansel et al have been considered but are moot in view of the modified rejections.

Applicant's arguments with respect to the ODP have been considered but are moot in view of the modified rejections.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Soroush whose telephone number is (571)272-5008. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER